REMARKS

Claims 2 and 4 are active, claim 5 being withdrawn from consideration.

Claim 2 is finally rejected under 35 USC 103a as being unpatentable over Wood (US Patent 5,733,399) in view of Straughan '758 and either one of Ganser '257 or Bliss '846 and is rejected under 35 USC 103a over Ndebi et al. (US Patent 6,217,964) in view of Bliss (US Patent 3, 964,846) or Ganser. Claim 4 is rejected under 35 USC 103a as being unpatentable over Wood, '758 and either one of '257 and '846 in view of Fujiwara et al. (US Patent 5,630,770).

The references to Ganser, Straughan are new and form a new grounds of rejection. Applicants have filed a request to withdraw the finality of the final rejection as premature in a separate paper. The request was denied in the Advisory Action dated June 8, 2004. The reason for denial is that applicants requested that a reference be cited. This reason is not sound. A new grounds of rejection are formed by the new references not mandated by any amendments made to the claims. This is improper. MPEP 706.07(a) states:

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new grounds of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement . . .(underlining added)

Plainly, the new grounds of rejection are not based on any amendment

made to the claims. The fact that the Examiner used improper basis for rejection of the claims in the first Office Action of 9/16/03 necessitating he provide references to support his position is of no moment in whether the new references are or are not a new grounds of rejection. Since the new references are not based on any claim amendments, the finality of the Office Action is in error and should be withdrawn. Applicants also filed a Petition to Withdraw the Finality of the Office Action on June 21, 2004. See this petition which sets forth further reasons for the error in the finality of the final rejection.

Claim 2, as amended herein, calls for:

> forming a solid rubber sheet;
>
> laying said solid rubber sheet onto a seamless substrate film while abutting both ends of said rubber sheet to form a cylinder and adhering the rubber sheet to the seamless substrate film to form a cylindrical laminate;
>
> placing said cylindrical laminate between an outer casing mold and a core mold where either said solid rubber sheet or said seamless substrate film faces radially inwardly; and
>
> applying a pneumatic pressure to said cylindrical laminate for vulcanizing said rubber sheet and for adhering said rubber sheet to said substrate film to form a one piece laminated cylinder (underlining added)

An applicant is entitled to fully respond to the new grounds of rejection as if a non-final action was involved.

The Substantive Rejections under 103(a)

Claim 2 is rejected over Wood in view of certain of the secondary references and over Ndebi in view of others of the secondary references.

The Advisory states that the prior amended claims calling for a composite is not commensurate with the scope of the arguments made in applicants' prior response. This is believed to exalt form over substance. The term composite refers to a laminated structure. The Advisory states the term composite only requires distinct structure and not require laminated layers. Applicants disagree. The term composite is not so broad as to encompass two overlying layers not otherwise attached. The term "composite" would be meaningless in this context. To address this issue, claim 2 is amended to expressly call for the laminate structure.

It should be noted that original filed claim 2 called for

"forming . . . into a laminated cylindrical shape."

Thus, there are no new issues regardless of whether or not the finality of the final rejection is withdrawn or not. The Examiner was under an obligation to originally search for the laminate structure. If he was not sure of what this meant he was obligated to at least review the specification, which apparently was not done, and in any case he was obligated to search for the laminate structure. See the MPEP 22143.03, p. 2100-128, stating that "Indefinite limitations must be considered."

See the specification page 5, lines 6-8 which specifically states "The cut rubber sheet and a seamless film are laminated . . . so as to form a cylindrical shape." Therefore, the present amendment does not introduce any new issues as compared to the originally filed claim 2 and claim 2, amended, should be examined on the merits.

The two step process of forming the laminated cylinder formed of applying the rubber sheet to the film as called for in amended claim 2 is missing in Wood ('399) and in Ndebi as admitted in the Office Action. It should be understood that the claim calls for a lamination. It should be recalled that the Examiner required applicants to delete the term "laminated" from the original filed claims in the Office Action dated May 2, 2003 under 35 U:SC 112. Applicants complied with this request in the interest of advancing the prosecution of this application. The term "laminate" finds full support in the original filed application, page 5, as noted above. This term is correct to describe the layer of rubber and film. There was nothing objectionable about the term laminate. The undersigned is advised that the original Japanese priority document with respect to this clause as literally translated states "The cut rubber sheet and a seamless film are pressed together so as to be adhered physically to each other." This is what was meant by the term "laminate" in the as filed claims and specification. This pressing together to form the lamination means that the two sheets are attracted to each other by a physical

phenomena such as static cling or other attractive mode of the two layers. Therefore, the term laminate in the original claims was clear and accurate and the objection thereto was not well founded. In a telephone interview with the Examiner's supervisor, Mr. Aftergut, regarding the above remarks, he stated he would continue the final rejection and would not enter the present amendment. Applicants respectfully request reconsideration of this conclusion in view of the above remarks that no new issues are presented by the present amendment.

No adhesive or other bonding medium is used to form the claimed laminate which is adhered layers. The layers are physically attracted to each other and held together by physical phenomena whereas vulcanization provides a more permanent molecular or chemical bond.

Neither reference, or any other reference cited of record, discloses a first step of forming a laminate of a rubber layer and a seamless film layer, outside the mold without additional structure and then, in a second step, inserting the laminate inside the mold between an outer casing mold and a core mold for vulcanization as claimed. See applicant's above referred to paragraph **[00021]**, specification page 5, lines 6-8, wherein the cut rubber sheet and seamless film are formed into a cylindrical shape outside the mold. Then the laminate without other structure is placed inside the mold between the outer casing and core molds to be vulcanized in the mold, Page 5, lines 11-12. This two step process does not

occur in Wood or Ndebi. Both references disclose that the layers are formed inside the mold as admitted in the Office Action.

The Office Action cites Ganser as suggesting this two step process. This is error. Ganser discloses that fully preformed belts made by undisclosed processes are inserted into the mandrel of the reference. The belt so inserted is a completely formed belt, are not the same as the laminate as claimed and do not require vulcanization in the mold as in claim 2. The belt is inserted into the mold to be further processed by a cutting step which forms the belt into further shapes and is not for vulcanization as claimed. Therefore, the vulcanization step is missing in Ganser, which does not suggest the two step process of forming multiple layers into a laminate outside a mold for later placement between an outer casing mold and a core mold and vulcanized as claimed. Thus, there is no motivation for one of ordinary skill to do what is claimed based on this reference.

Bliss is also cited for disclosing the two step process. This is also error. In Bliss, the belt to be cured is first built up in a usual manner. Col. 3, lines 37-38. Bliss however does not state how the belt is built up or with what elements. Bliss does not state that the layers so formed form a laminate as claimed, i.e., the elements, much less a rubber sheet and film as claimed, are adhered physically to one another without additional elements. There is no basis in this reference to assume that no support structure is employed to build up the belt in the "usual

manner." Further, the Bliss belt comprises different elements than the claimed laminate comprising the rubber layer and film as claimed.

The Bliss belt so built up, by means not disclosed, is placed over the mold inner assembly 12, which is first removed from the mold, Col. 3, lines 59-63. There is no teaching in this reference that a two layer laminate comprising a rubber layer and a film layer would, could or should be so formed. Bliss builds up the belt with the usual various layers forming the complete belt comprising structure different the claimed layers. This is different than what is claimed. The inner mold assembly receives the built up belt attached, not disclosed as a laminate as claimed, and is then positioned in the mold. Lines 64-66. This is not what is claimed.

The claimed steps are not performed or suggested by Bliss which does not go so far. Thus in the claimed two step process the rubber layer and film are formed into a laminate first held together by physical phenomena without the use of supporting mold elements as in Bliss, and then in the second step the laminate is placed between both the outer casing mold and the inner core mold. In Bliss, the layers are formed by a process not disclosed, are not disclosed as forming a laminate as claimed, and then transferred onto the inner mold. Then the combination of belt layers (not a laminate) formed by that undisclosed process and inner mold are placed into the mold adjacent the outer mold. This is different than and does not suggest what is claimed. The layers of the claimed laminate are

adhered to one another outside the mold without other structure. There is no basis in Bliss that the formed belt prior to placement on the inner mold is as claimed. The implication is that it is resting on another support structure and merely transferred from one support structure to another. The layers of such a belt are not disclosed as and do not form a laminate as disclosed.

Bliss not only does not suggest what is claimed because Bliss requires a support structure for the layers, but teaches away from forming a laminate much less a laminate without the support structure, which structure requires more complexity and cost in the mold, the antithesis of obviousness. The remaining references cited of record are believed even more foreign to claim 2. This claim is believed allowable.

Claim 4 depends from claim 2 and is believed allowable for the same reasons.

For the reasons given, claims 2 and 4 are believed to be in condition for allowance, and such favorable action is hereby solicited.

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